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Patent
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March 28, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Post Office Box 1450
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Re: Previous Appeal No.: 2003-0831
Application Serial No.: 09/193,647
Confirmation No.: 2284
Appellants: Usner, et al.
Title: Apparatus and Method for Indicating the Status
of Transaction Function Devices in an
Automated Banking Machine
Docket No.: D-1077+11

Sir:

Please find enclosed the Supplemental Appeal Brief of Appellants pursuant to 37 C.F.R. § 41.37 for filing in the above-referenced application.

A fee (\$320) has already been paid for a previously filed Appeal Brief. Therefore, please charge the fee for this Supplemental Appeal Brief filing (\$180) and any other fee due to Deposit Account 09-0428.

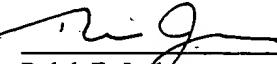
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Ralph E. Jocke
Reg. No. 31,029

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: **2003-0831**)
In re Application of: **Usner, et al.**)
Application No.: **09/193,647**) Art Unit 3621
Confirmation No.: **2284**)
Filed: **November 17, 1998**) Patent Examiner
Title: **Apparatus and Method for**)
Indicating the Status of)
Transaction Function Devices)
in an Automated Banking Machine)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby request reinstatement of their appeal. The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Supplemental Appeal Brief is in response to the Office Action dated November 18, 2004, which reopened prosecution.

Adjustment date: 04/04/2005 HAL111
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01 FC:120 320.00 CR

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04/04/2005 HAL111
01 FC:1402

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii)

RELATED APPEALS AND INTERFERENCES

Prosecution was reopened following a Remand (dated June 29, 2004) in previously assigned Appeal No. 2003-0831.

Other applications (09/193,564; 09/193,646; 09/193,662; 09/193,787; 09/193,791) having been assigned appeal numbers claim priority to parent application 09/077,337, which claims priority to Provisional application 60/031,956 filed 11/27/1996. It is believed that these other appeals do not pertain to the claimed subject matter. However, it is respectfully requested that the Board of Appeals and Interferences (“Board”) make its own determination regarding the pertinence of these other applications. The Board is also requested to check (update) the status of other applications claiming priority to the parent application with regard to appeal.

Appellants, Appellants’ legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-19 are pending in the Application.

Claims rejected: 1-19

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-19, inclusive. The rejections were present in the Office Action (“Action”) dated November 18, 2004.

(iv)

STATUS OF AMENDMENTS

The non-final Action dated November 18, 2004 reopened prosecution following a Remand to the Examiner (dated June 29, 2004) from the Board. Appellants respectfully request reinstatement of their appeal.

No final rejection has been made. However, claims have been rejected at least twice. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

Additional Comments

The Examiner's response to the Remand dated June 29, 2004

The Examiner did not directly respond to the Remand with regard to the issue of Appellants' claim for priority to the November 27, 1996 filing date of Provisional application 60/031,956. However, the Examiner does state in the Action that Appellants' claim for priority has finally been considered, and as a result the previous rejections (based on the BankNet Article) have been withdrawn. Therefore, Appellants respectfully submit that by inference the Office admits that Appellants are entitled to the November 27, 1996 priority date.

Also, the Examiner did not respond to the Remand with regard to timeliness. The Remand specifically pointed out that this application had "special" status and was to receive *immediate* action by the Examiner. The Remand was dated June 29, 2004. However, the Examiner did not respond thereto (via the Action) until November 18, 2004.

The alleged updated search

The Action (on page 2) alleges that the new reference (i.e., Wagner) was found as a result of an *updated* search. This cannot be true as Wagner's issue date (April 21, 1998) is earlier than Appellants' filing date (November 17, 1998).

An "updated search" includes reviewing only newly available art, such as newly issued patents in a class/subclass previously searched. One skilled in the art of searching knows (and the MPEP confirms) that an "updated search" is an update of a search previously made. MPEP § 719.05 (I) (C) (page 700-274; Rev. 2, May 2004). The Wagner reference is not a newly issued patent. Again, Wagner was actually issued before the pending application was even filed. Thus, it is unclear how Wagner could have been found in an "updated search." Instead, it appears that the Office has purposely gone outside of the normal bounds of examining for Appellants' application, especially in light of the Remand's simple request. The Office has provided no other (valid) explanation or evidence. Such action constitutes unacceptable arbitrary and capricious action by the Office (especially Art Unit 3621) against Appellants.

The new Vak-based rejections

Claims 16-19 were previously rejection based on Vak *alone* (resulting in Appellants having to file an appeal). The fact that the BankNet Article did not constitute prior art had no bearing on the Vak rejection of claims 16-19. That is, the Remand did not cause claims 16-19 to be reconsidered. However, these same claims are now rejected based on Vak in view of another reference.

Appellants are not pleased (after having to file arguments; then a notice of appeal; then an appeal brief; and then a reply brief) that now the Examiner admits that Vak does not teach or

suggest the recited features and relationships. The Examiner's handling of this application is not in conformance with the Office's normal and expected examining procedures, especially with regard to "compact prosecution." Why any Examiner would once again examine claims that he did not have to appears to point to PTO management (especially Art Unit 3621) as engaging in deliberate arbitrary and capricious action against Appellants.

The Board itself points out additional improper actions by the Office in the Remand. Appellants are also not pleased that the Examiner never even determined the effective filing date of their application, in spite of Appellants' numerous requests and confirmations that the BankNet Article did not constitute prior art, until forced to do so by the Board (via Appellants having to file an unnecessary appeal). It should come as no surprise that the impropriety of the new rejections on appeal is merely reflective of the numerous previous improprieties by the Office concerning this application.

Appellants, in an attempt to prevent the Office from causing even further *unnecessary* prosecution delay, desire to proceed with their appeal. Furthermore, as shown in more detail herein, Appellants' claims are allowable over the (latest) new grounds of rejection. Thus, Appellants respectfully request reinstatement of their appeal.

Appellants respectfully request that the Board not grant the Examiner yet another try to meet the required statutory burden via another remand. If a case of unpatentability was not already established by the Office at the time of appeal, then the rejections should be reversed. Following reversal, when jurisdiction is returned to the examining group, the Examiner still has ample opportunity to take further action. Even so, Appellants acknowledge that it is the sole discretion of the Board to determine the best course of action.

(v)

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is directed to an apparatus. The apparatus comprises an automated transaction machine (e.g., 12) including at least one transaction function device (e.g., 36; Figure 2). A server (e.g., 109) is in operative connection with the transaction function device. At least one HTML document includes indicia corresponding to the status of the transaction function device. The HTML document is accessible through the server. Particularly note page 55, line 20 to page 58, line 9, and Figure 2.

With respect to independent claim 7

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes operating a transaction function device (e.g., 36; Figure 2) in an automated transaction machine (e.g., 12). The transaction function device (e.g., 36; Figure 2) has an associated status. The method further includes generating at least one HTML document including instructions corresponding to the status of the transaction function device (e.g., page 56, lines 1-9). Particularly note page 55, line 20 to page 58, line 9, and Figure 2.

With respect to independent claim 12

Another exemplary form of the invention is directed to an apparatus. Support in the disclosure for similar claim language has previously been provided. The apparatus includes an automated transaction machine (e.g., 12) including a plurality of transaction function devices (e.g., 36; Figure 2). Each of the transaction function devices has an associated status indicative of an operative condition of the transaction function device. The apparatus further includes a transaction machine computer (e.g., 34) in operative connection with the transaction function devices (e.g., page 13, lines 11-12). The apparatus further comprises machine software (e.g., 64, 109) executable in the computer (e.g., page 14, lines 11-13). The software includes a server (e.g., 109) (e.g., page 55, line 5). The software (e.g., 109) is operative to cause the computer (e.g., 34) to generate at least one HTTP record including indicia representative of the status of at least one transaction function device (e.g., page 56, lines 1-9). The HTTP record is accessible through the server.

With respect to independent claim 16

Another exemplary form of the invention is directed to an apparatus. Support in the disclosure for similar claim language has previously been provided. The apparatus comprises an automated transaction machine (e.g., 12). The automated transaction machine comprises a plurality of transaction function devices (e.g., 36; Figure 2) including at least one note dispensing device (e.g., 42; Figure 2). The automated transaction machine further includes at least one computer (e.g., 34). The at least one computer is in operative connection with the plurality of transaction function devices (e.g., 36; Figure 2). The at least one computer is operative to cause

the at least one note dispensing device (e.g., 42) to dispense at least one note from the machine (e.g., 12). The at least one computer (e.g., 34) is operative responsive to the occurrence of a malfunction of one of the transaction function devices to include indicia in at least one HTTP record representative of the malfunction (e.g., page 56, lines 1-9). The automated transaction machine (e.g., 12) further includes a communications connection in operative connection with the at least one computer (e.g., 34) in the machine. At least one HTTP record is accessible by a computer (e.g., 110) external of the machine through the communications connection (e.g., page 56, lines 15-17; page 57, lines 1-3).

With respect to independent claim 18

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes operating a plurality of transaction function devices (e.g., 36) in an automated transaction machine (e.g., 12) that is operative to dispense (e.g., 42) at least one note. In response to a malfunction of at least one of the transaction function devices, indicia is included in at least one HTTP record representative of the malfunction (e.g., page 56, lines 1-9). The method further includes accessing the HTTP record with an external computer (e.g., 110) through a communications connection to the machine (e.g., page 56, lines 15-19; page 57, lines 1-3).

With respect to independent claim 19

Another exemplary form of the invention is directed to an apparatus. Support in the disclosure for similar claim language has previously been provided. The apparatus comprises an automated transaction machine (e.g., 12) including a plurality of transaction function devices (e.g., 36; Figure 2). The automated transaction machine (e.g., 12) includes a server (e.g., 109) in operative connection with the plurality of transaction function devices (e.g., 36). The automated transaction machine (e.g., 12) further includes at least one HTTP record including indicia representative of an operational status of at least one of the plurality of transaction function devices (e.g., 36) (e.g., page 56, lines 1-9). The automated transaction machine (e.g., 12) also includes a communications connection in operative connection with the server (e.g., 109) that is adapted to communicate the at least one HTTP record to a computer (e.g., 110) outside the machine.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claims 1-15 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Wagner (US 5,742,845).
- 2). Whether claims 16-19 are unpatentable pursuant to 35 U.S.C. § 103(a) over Vak, et al. (US 5,473,143) (hereinafter “Vak”) in view of Wagner.

(vii)

ARGUMENT

The 35 U.S.C. § 102(e) Rejections

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Wagner does not anticipate the claims

Claims 1-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wagner.

The Office broadly alleges that Wagner teaches the recited invention somewhere in col. 1, lines 14-67; col. 3, lines 16-67; col. 6, lines 1-67; and col. 7, lines 1-64. The Action is silent as to where Wagner *specifically* teaches all of the recited features and relationships. The Appellants argue each of the claims on appeal separately. Appellants respond to the claim rejections (as best understood) in spite of the Action's failure to provide a claim by claim analysis of how Wagner teaches the claimed invention.

Appellants respectfully traverse the rejections. The Office apparently relies on an ATM in Wagner for the recited automated transaction machine. The Appellants respectfully disagree. Nevertheless, ATM and automated transaction machine will be used interchangeably herein.

Wagner does not teach the recited invention. Where does Wagner discuss the status of a transaction function device, especially in the relied upon sections thereof? Where does Wagner even mention "status"? The Office's allegation of anticipation is not supported by Wagner. Nor has any additional evidence been presented that Wagner teaches the recited invention. Wagner does not anticipate the claims.

Claim 1

Claim 1 positively recites "at least one HTML document" including "indicia corresponding to a status of the transaction function device" of "an automated transaction machine." Where does Wagner teach an HTML document having indicia corresponding to a status of a transaction function device of an ATM (i.e., the alleged automated transaction

machine)? Where does Wagner further teach a server, through which the HTML document is accessible, in operative connection with the transaction function device?

Furthermore, ATMs in Wagner are mentioned only in the prior art Background section. Wagner mentions “ATM” at col. 1, lines 26, 29, 47, 60, 65; col. 2, line 1; and col. 4, line 24. An ATM is *not* a part of Wagner’s invention.

Wagner teaches neither the features nor the relationships of an automated transaction machine, at least one transaction function device, server, and at least one HTML document (including status indicia) in the manner recited. It follows that Wagner cannot anticipate claim 1.

Claim 2

Wagner further does not teach an automated transaction machine transaction function device that is operative responsive to an HTTP message received by a server that is in operative connection with the device. Where does Wagner relate operation of an automated transaction machine transaction function device to a server-received HTTP message? Wagner does not anticipate claim 2.

Claim 3

Wagner further does not teach an HTML document having indicia corresponding to a fault which has occurred in an automated transaction machine transaction function device. Where does Wagner relate HTML document indicia to a transaction function device fault? Wagner does not anticipate claim 3.

Claim 4

Wagner further does not teach an HTML document including indicia corresponding to status of each of a plurality of transaction function devices of an automated transaction machine.

Where does Wagner relate status of plural transaction function devices to an HTML document?

Wagner does not anticipate claim 4.

Claim 5

As previously discussed, ATMs are mentioned only in the prior art Background section in Wagner. Regardless, Wagner does not teach the recited ATM. Nor does Wagner anticipate claim 5.

Claim 6

Wagner further does not teach the recited portable terminal including a browser. Where does Wagner teach a portable terminal that can access through a server (that is in operative connection with a transaction function device) HTML documents having indicia corresponding to the status of an automated transaction machine transaction function device? Where does Wagner teach the recited automated transaction machine, transaction function device, server, HTML document, and portable terminal relationship? Wagner does not anticipate claim 6.

Claim 7

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. For reasons already discussed, Wagner does not teach the step of generating at least one HTML document including instructions corresponding to the status of a transaction function device in an automated transaction machine. Where does Wagner discuss the status of a transaction function device in an automated transaction machine? Where does Wagner relate HTML document instructions to automated transaction machine transaction function device status? Wagner does not anticipate claim 7.

Claim 8

Wagner further does not teach accessing a generated HTML document (of claim 7) with a terminal including a browser. Where does Wagner teach using a browser to access an HTML document corresponding to the status of an automated transaction machine transaction function device? Wagner does not anticipate claim 8.

Claim 9

Claim 9 depends from claim 8/7. Wagner further does not teach accessing a generated HTML document (of claim 7) with a portable terminal adjacent to an automated transaction machine. Where does Wagner teach accessing an HTML document (corresponding to the status of an automated transaction machine transaction function device) with a portable terminal adjacent to the automated transaction machine? Wagner does not anticipate claim 9.

Claim 10

Claim 10 depends from claim 8/7. Wagner further does not teach accessing a generated HTML document (of claim 7) through a network with a terminal located remotely from the automated transaction machine. Where does Wagner teach accessing (through a network) an HTML document (corresponding to the status of an automated transaction machine transaction function device) with a terminal located remotely from the automated transaction machine? Wagner does not anticipate claim 10.

Claim 11

As previously discussed, Wagner does not teach generating at least one first HTML document including first instructions corresponding to the status of an automated transaction machine transaction function device. Wagner further does not teach *receiving* with the

automated transaction machine an HTML document including second instructions. Nor does Wagner teach operating the transaction function device responsive to the second instructions. Where does Wagner generate an HTML document including transaction function device status instructions, receive an HTML document including second instructions, and operate the transaction function device responsive to the second instructions? Wagner does not anticipate claim 11.

Claim 12

Appellants' remarks in support of the patentability of claims 1 and 7 are incorporated herein by reference. For reasons already discussed, Wagner does not teach the recited apparatus. Where does Wagner discuss the status of transaction function devices in an automated transaction machine? Where does Wagner teach software that can cause a transaction machine computer to generate at least one HTTP record including indicia representative of the operative condition of at least one transaction function device? Where does Wagner further teach that the software also includes a server through which the HTTP record is accessible? Wagner does not anticipate claim 12.

Claim 13

Wagner further does not teach software that can cause a transaction machine computer to generate at least one accessible HTTP record (comprising an HTML document) that includes indicia representative of the operative condition of at least one automated transaction machine transaction function device. Wagner does not anticipate claim 13.

Claim 14

Wagner further does not teach software that can cause a transaction machine computer to generate at least one accessible HTTP record (comprising a data object) that includes indicia representative of the operative condition of at least one automated transaction machine transaction function device. Wagner does not anticipate claim 14.

Claim 15

Claim 15 depends from claim 14/12. Wagner further does not teach a communications connection operatively connecting the transaction machine computer (claim 12) and a terminal computer, especially where terminal software and machine software are operative to transfer the data object (claim 14) from the transaction machine to the terminal computer. Where does Wagner teach (machine and terminal) software with the combined ability to cause generation of a transaction function device status HTTP record (with a data object) and to transfer the data object from a transaction machine to a terminal computer? Wagner does not anticipate claim 15.

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The 35 U.S.C. § 103(a) rejections are legally improper

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness. Additionally, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Claims Are Not Obvious Over
Vak in view of Wagner**

Claims 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Wagner.

While Appellants discuss the Vak reference herein, such discussion in no way constitutes an admission or agreement that Vak in any way provides an enabling disclosure or that Vak otherwise constitutes a valid patent.

The Action is silent as to where the applied references *specifically* teach or suggest all of the recited features and relationships. The Appellants argue herein each of the rejected claims separately. Appellants respond to the claim rejections (as best understood) in spite of the Action's failure to provide a claim by claim analysis of how the applied references teach or suggest the claimed invention.

The Action admits (on page 4) that Vak does not teach or suggest "a HTTP record representative of the malfunction." The Action relies on Wagner as allegedly teaching "an open network protocol that is implemented in Hypertext transport protocol (HTTP)". The Action further alleges that it would have been obvious "to modify the ATM of Vak by including a HTTP . . . to view a specific Web page in the Internet".

Appellants respectfully traverse the alleged teachings of Vak and Wagner (and the rejection). The rejections lack the necessary evidence and rationale. There is absolutely no teaching, suggestion, or motivation in the applied references concerning a HTTP record in the manner recited. Nor is there any teaching, suggestion, or motivation to modify Vak in view of Wagner to produce the recited invention. Even if it were somehow possible (which it isn't) to modify Vak with the teaching of Wagner to somehow view a specific Internet Web page as alleged, the record still would not factually support a *prima facie* conclusion of obviousness.

Claim 16

Appellants' remarks in support of the patentability of claims 1 and 12 are incorporated herein by reference. There is absolutely no teaching, suggestion, or motivation in the applied references of an HTTP record including indicia representative of an automated transaction machine transaction function device *malfunction*, especially where the HTTP record is accessible by a computer external of the automated transaction machine. The references do not teach or suggest (nor does the Office even allege) any correlation between an HTTP record and a *malfunction* of a transaction function device.

As previously discussed, the Action admits (on page 4) that Vak does not teach or suggest "a HTTP record representative of the malfunction". That is, the Office admits that Vak does not teach or suggest an (at least one) automated transaction machine computer in operative connection with a plurality of transaction function devices (including at least one note dispensing device) of the automated transaction machine, and having the structural ability to include indicia in an (at least one) HTTP record representative of a malfunction of one of the transaction function devices. It follows that Vak does not teach or suggest having a computer in the ATM that is operative, responsive to the occurrence of a malfunction of a transaction function device, to include indicia in an HTTP record representative of the device malfunction.

Appellants respectfully submit that Vak lacks more of the recited features and relationships than the Action admits. For example, the Action (on page 4) alleges that Vak teaches the communications connection. However, where do the relied upon sections of Vak (col. 9, lines 1-67; col. 10, lines 1-22) teach or suggest a communications connection that enables a (malfunction representative) HTTP record to be accessed by a computer external of the

machine, especially with the admission that Vak does not even teach or suggest “a HTTP record representative of the malfunction”? It follows that Vak does not teach or suggest a communications connection to the machine computer which enables the HTTP record, which includes the indicia representative of the malfunction, to be externally accessed.

Also, the Action (on page 4) alleges that Vak at col. 4, lines 7-24 teaches that “at least one note dispensing device is included among the plurality of transaction function devices” and that “at least one computer is in operative connection with the plurality of transaction function devices, and wherein the at least one computer is operative to cause the at least one note dispensing device to dispense at least one note from the machine”. However, where does this particular relied upon section of Vak teach or suggest the features as alleged?

Vak appears directed to an electronic mail system in which a user can use an ATM terminal to conduct transactions and send and receive electronic mail text messages. Vak is not concerned with sending or receiving electronic mail relating to a transaction function device malfunction. Nor would a user of Vak's electronic mail system, who is charged fees for usage of the mail system (col. 26, lines 1-2), be concerned with or have any ability to know about a bank's malfunctioned ATM device. Nor does Vak have any need of an HTTP record representative of an ATM transaction function device malfunction.

Furthermore, there is no disclosure or suggestion in Vak that the electronic mail system is associated with the Internet (col. 1, lines 35-45), as the Action alleges with Wagner. Contrarily, Vak appears limited to the dedicated lines of ATM and POS systems using EFT networks and a dedicated system for sending text messages (col. 1, lines 46-50; col. 5, lines 26-33). Vak also requires a card (48) to access a terminal in order to use the electronic mail system. Again, Vak

has no need or desire for an HTTP record, or for including indicia representative of a malfunction of a device in such an HTTP record.

The Action's reliance on Vak at col. 9, line 1 to col. 10, line 22 is respectfully traversed. Vak's status panel (156), which is part of a terminal's input/output console (130), has indicators to inform a terminal user of "the various *states* (or status) of a transaction being performed" (col. 10, lines 9-12). This appears to be a reference to conventional prior art ATM outputs that advise a user of information such as the user's transaction is being processed or that the user's transaction could not be processed (e.g., due to invalid card/PIN, improper user entry/request, etc.). ATMs have been programmed for many years to output such messages to users. Some early ATM type machines outputted such messages to users by having them printed on a rotating drum that rotated to a particular angular position to display the appropriate message to the user depending on the state of the transaction. That some prior ATMs (like Vak's ATM) output such messages from the ATM to a user, discloses or suggests nothing concerning an HTTP record including indicia indicative of an ATM device malfunction. Further, nothing in Vak (or Wagner) discloses or suggests communicating such HTTP messages to a computer external to the ATM.

Wagner cannot alleviate the deficiencies of Vak as it does not teach or suggest the recited features and relationships which are not found in Vak. For reasons previously discussed (e.g., remarks in support of the patentability of claims 1 and 12), Wagner does not teach the recited apparatus. Wagner (like Vak) does not teach or suggest having an automated transaction machine computer that is operative, responsive to the occurrence of a malfunction of a transaction function device of the machine, to include indicia in an HTTP record representative of the device malfunction. Wagner (like Vak) is not concerned with an automated transaction

machine transaction function device malfunction. Nor is Wagner (like Vak) concerned with a HTTP record including indicia representative of the malfunction. Nor is Wagner (like Vak) concerned with a communications connection to an automated transaction machine computer that enables the (malfunction representative) HTTP record to be externally accessed.

The references, taken alone or in combination, do not teach or suggest the recited features and relationships. As previously discussed, the Office doesn't even allege that the references teach or suggest a relation between an HTTP record and a malfunction of an automated transaction machine transaction function device. Appellants respectfully submit that in light of the failure of the applied references to teach or suggest all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejection is not valid. *In re Zurko*, *supra*. *In re Lee*, *supra*. It would not have been obvious to one having ordinary skill in the art to have modified Vak as alleged to have produced the recited apparatus. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, *supra*. Even if it were somehow possible (which it isn't) to modify Vak with the teaching of Wagner as alleged, the modification would not have resulted in the recited apparatus. The Office has not established a *prima facie* showing of obviousness.

Claim 17

Claim 17 depends from claim 16. For reasons already discussed, the references, taken alone or in combination, do not teach or suggest the recited ATM. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 18

Appellants' remarks in support of the patentability of claim 16 are incorporated herein by reference. For reasons already discussed, the references, taken alone or in combination, do not teach or suggest, responsive to a malfunction of at least one automated transaction machine transaction function device, including indicia in a (at least one) HTTP record representative of the malfunction. Nor do they teach or suggest accessing the HTTP record with an external computer through a communications connection to the automated transaction machine.

Again, the attempt to modify Vak is based solely on impermissible hindsight reconstruction of Appellants' claimed invention. It would not have been obvious to one having ordinary skill in the art to have modified Vak as alleged to have produced the recited method. Even if it were somehow possible (which it isn't) to modify Vak with the teaching of Wagner as alleged, the result still would not teach or suggest the recited method. The Office does not factually support any *prima facie* conclusion of obviousness.

Claim 19

Appellants' remarks in support of the patentability of claim 16 and 18 are incorporated herein by reference. For reasons already discussed, the references, taken alone or in combination, do not teach or suggest an automated transaction machine including a (at least one) HTTP record, especially where the HTTP record includes indicia representative of an operational status of at least one of a plurality of transaction function devices of the automated transaction machine. Nor do the references teach or suggest an automated transaction machine including a machine communications connection in operative connection with a machine server that is in operative connection with the plurality of machine transaction function devices, especially where the

communications connection is adapted to communicate the HTTP record to a computer outside of the automated transaction machine. The references, taken alone or in combination, do not teach or suggest the recited features or relationships of automated transaction machine transaction function devices, server, communications connection, and at least one HTTP record.

The Action is devoid of any prior art teaching, suggestion, or motivation for modifying Vak with Wagner as alleged so as to produce the recited invention. Nor would it have been obvious to one having ordinary skill in the art to have modified Vak as alleged to have produced the recited invention. Even if it were somehow possible (which it isn't) to modify Vak with the teaching of Wagner as alleged, the modification would not have resulted in the recited invention of claim 19. The Office has not established a *prima facie* showing of obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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1. Apparatus comprising:

an automated transaction machine including at least one transaction function device, a server in operative connection with the transaction function device, at least one HTML document accessible through the server, wherein at least one first document includes indicia corresponding to a status of the transaction function device.

2. The apparatus according to claim 1 wherein the transaction function device is operative responsive to an HTTP message received by the server.

3. The apparatus according to claim 1 wherein the status is representative of a fault which has occurred in the transaction function device.

4. The apparatus according to claim 1 wherein the machine includes a plurality of transaction function devices, and wherein the HTML document accessible through the server include indicia corresponding to a status of each of a plurality of transaction function devices.

5. The apparatus according to claim 1 wherein the machine is an ATM.

6. The apparatus according to claim 1 and further comprising a portable terminal, wherein the portable terminal includes a browser, wherein the terminal is operative to access documents through the server.

7. A method comprising:

operating a transaction function device in an automated transaction machine, the transaction function device having an associated status; and

generating at least one first HTML document including first instructions corresponding to the status of the transaction function device.

8. The method according to claim 7 and further comprising the step of accessing the first document with a terminal including a browser.

9. The method according to claim 8 wherein the accessing step includes accessing the first document with a portable terminal adjacent to the automated transaction machine.

10. The method according to claim 8 wherein the accessing step includes accessing the first document through a network with a terminal located remotely from the automated transaction machine.

11. The method according to claim 7 and further comprising the steps of:

receiving a second HTML document with the machine, the second document including second instructions; and

operating the transaction function device responsive to the second instructions.

12. Apparatus comprising:

an automated transaction machine including a plurality of transaction function devices, wherein each of the transaction function devices has an associated status, wherein the status is indicative of an operative condition of the transaction function device;

a transaction machine computer in operative connection with the transaction function devices, and further comprising machine software executable in the computer, wherein the software is operative to cause the computer to generate at least one HTTP record including indicia representative of the status of at least one transaction function device, and wherein the software further includes a server, wherein the first HTTP record is accessible through the server.

13. The apparatus according to claim 12 wherein the HTTP record comprises an HTML document.

14. The apparatus according to claim 12 wherein the HTTP record comprises a data object.

15. The apparatus according to claim 14 and further comprising a terminal computer outside the automated transaction machine, a communications connection operatively connecting the transaction machine computer and the terminal computer, and further comprising terminal software in the terminal computer, wherein the terminal software and the machine software are operative to transfer the data object from the transaction machine to the terminal computer.

16. Apparatus comprising:

An automated transaction machine including:

a plurality of transaction function devices, wherein at least one note dispensing device is included among the plurality of transaction function devices,

at least one computer operative in the machine, wherein the at least one computer is in operative connection with the plurality of transaction function devices, and wherein the at least one computer is operative to cause the at least one note dispensing device to dispense at least one note from the machine,

wherein the at least one computer is operative responsive to the occurrence of a malfunction of one of the transaction function devices to include indicia in at least one HTTP record representative of the malfunction,

a communications connection in operative connection with the at least one computer in the machine, wherein the at least one HTTP record is accessible by a computer external of the machine through the communications connection.

17. The apparatus according to claim 16 wherein the automated transaction machine comprises an ATM.

18. A method comprising:

operating a plurality of transaction function devices in an automated transaction machine, wherein the machine is operative to dispense at least one note;

responsive to a malfunction of at least one of the transaction function devices, including indicia in at least one HTTP record representative of the malfunction;

accessing the HTTP record with an external computer through a communications connection to the machine.

19. Apparatus comprising:

An automated transaction machine including:

a plurality of transaction function devices,

a server in operative connection with the plurality of transaction function devices,

at least one HTTP record including indicia representative of an operational status of at least one of the plurality of transaction function devices,

a communications connection in operative connection with the server, wherein the communications connection is adapted to communicate the at least one HTTP record to a computer outside the machine.

(ix)

EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

(None)